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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,652	02/26/2002	Katsumi Yabusaki	K036-4537(PCT)	3872

7590 10/03/2003  
Adams & Wilks  
50 Broadway 31st Floor  
New York, NY 10004

EXAMINER

HANNAHER, CONSTANTINE

ART UNIT PAPER NUMBER

2878

DATE MAILED: 10/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/069,652

Applicant(s)

YABUSAKI ET AL.

Examiner

Constantine Hannaher

Art Unit

2878

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 February 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### **National Stage Application**

1. The Examiner acknowledges consideration of the International Preliminary Examination Report in International Application PCT/JP00/06342. MPEP § 1893.03(e).

### **Information Disclosure Statement**

2. The references cited in the Search Report for PCT/JP00/06342 have been considered, but will not be listed on any patent resulting from this application because they were not provided on a separate list in compliance with 37 CFR 1.98(a)(1). In order to have the references printed on such resulting patent, a separate listing, preferably on a PTO-1449 form, must be filed within the set period for reply to this Office action.

### **Drawings**

3. The drawings are objected to because in Fig. 2 an abbreviation for the metric system unit cubic centimeter (cc rather than  $\text{cm}^3$ ) is apparent. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Proper use of the metric system is a requirement of PCT Rule 10.1(a).

### **Claim Rejections - 35 USC § 103**

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsui *et al.* (EP0926482A3) in view of Slovacek *et al.* (US005242837A) and Bromberg (US0041055768A).

With respect to independent claim 1, Matsui *et al.* discloses an imaging device of the recited type (Fig. 1) comprising an imaging container 3 for containing the fluorescent particles collectively at the bottom 3' (paragraph [0023]), means 1 for producing exciting light that excites the fluorescent particles, first illumination means (including optics 2) for irradiating only a portion near the bottom of the imaging container with the exciting light from a side, and an imaging device 9 for imaging, from the bottom, the bottom of the imaging container illuminated by the first illumination means. Matsui *et al.* does not disclose second illumination means for irradiating the bottom of the imaging container from the bottom with the exciting light but Slovacek *et al.* shows (Fig. 3) that such irradiation with exciting light from lamp 34 of the bottom 12 of a container 16 from the bottom is known. Slovacek *et al.* does not appear to explain why the disclosed device irradiates from the bottom, but Bromberg explains (at column 1, lines 55-59) that so-called "front face" excitation illumination is useful for direct analysis of samples without dilution. Since Matsui *et al.* and Slovacek *et al.* are both in the art of blood analysis, as is Bromberg, and the elimination of the dilution step suggested by Bromberg would have been recognized as useful in that art, therefore it would have

been obvious to one of ordinary skill in the art at the time the invention was made to modify the imaging device of Matsui *et al.* to comprise a second illumination means for irradiating the bottom of the imaging container 3 from the bottom with the exciting light in view of the improved flexibility in being able to analyze undiluted blood samples as well as preparations from whole blood. A switching means for switching between the side face and front face modes (illumination means) in such a modified device would have been obvious in view of the need to adjust the device to accommodate the particular sample in imaging container 3.

With respect to dependent claims 2 and 3, the form of the switching means suggested by the combination of Matsui *et al.*, Slovacek *et al.*, and Bromberg is a choice within the ordinary skill in the art. An optical element (for example, a mirror) or a switch of exciting light sources are well known expedients for delivering light to multiple locations (as in scanners, for example).

### **Response to Submission(s)**

7. This application has been published as WO01/22064A1 on March 29, 2001 and again as EP1221607A1 on July 10, 2002.

### **Conclusion**

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Niino *et al.* (US006252235B1) and Niino *et al.* (US006211953B1) represent earlier work by one or more applicants but these references are potentially excludable.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Constantine Hannaher whose telephone number is (703) 308-4850. The examiner can normally be reached on Monday-Friday with flexible hours.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David P. Porta can be reached on (703) 308-4852. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

ch

  
Constantine Hannaher  
Primary Examiner